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EXAMINER

BELL, KENT L

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,020

Applicant(s)

IBES

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on papers filed 1/8/02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/~~are~~ pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/~~are~~ rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Status of Application

Applicant's substitute specification and abstract, including the amendments, and comments filed January 8, 2002 have been entered and fully considered but are not found persuasive as to the issues set forth in this Office action.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 6 and 7, Applicant states the instant cultivar is "a naturally occurring mutation of 'Melody' ". However, applicant has not set forth whether the instant cultivar is a whole plant mutation of 'Melody' or a branch mutation of 'Melody', or other. Applicant should set forth in the specification the type of naturally occurring mutation.

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B. Page 2, line 30, Applicant states "Umbel; Umbel on pedicel; pedicel on peduncle."

The recitation does not appear to be accurate as flowers make up the umbel and flowers are connected to the pedicel not the umbel connected to the pedicel. It appears applicant meant to say "Umbel; flowers on pedicel; pedicel on peduncle.". Correction and/or clarification is necessary.

C. Page 3, line 16 and page 4, line 3, As stated in the previous Office action mailed July 27, 2001, Applicant states "67C-D". It is uncertain whether applicant intends the color(s) set forth to be a mixture of the two color designations, a color that varies between the two color designations, or if each color is individually present. Correction and/or clarification is necessary.

D. Page 3, lines 9-16 and 25-31 to page 4, line 3, As stated in the previous Office action mailed July 27, 2001, Applicant should set forth additional information in the specification relative to the instant plant's petals and petaloids such as the typical and observed petaloid length.

E. Page 3, lines 18-24, As stated in the previous Office action mailed July 27, 2001, Applicant should set forth in the specification information relative to the instant plant's sepals such as the typical and observed apex descriptor.

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The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Claim Rejection - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number 981669 (European Union) in view of applicant's admission that 'Penber' was "sold outside the United States on or about March 1, 1999" (Page 2 of response filed January 8, 2002).

The European application number 981669 was published February 15, 1999. The published European application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. Copies of the European application (981669) are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months in an Official Gazette. This Official Gazette contains information appearing in the Register such as applications for protection, proposals for variety denomination and grants of title. Other information the Community Plant Variety Office feels important to the public may also be published in the Gazette.

Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference

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may be relied on to show the primary reference has an “enabled disclosure”. *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”). See also MPEP § 2121.03.

Applicant admits on page 2 of the response filed January 8, 2002 that the cultivar ‘Penber’ was sold outside the United States on or about March 1, 1999. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application’s United States filing date. The Plant Breeder’s Right application filing number 981669 is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, Biotechnology and the Law § 8.05 (1998 Clark Boardman Callaghan). “In essence then, a plant patent applicant

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cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.”

Applicant’s arguments have been fully considered as they apply to the new grounds of rejection.

Applicant believes a rejection under 35 U.S.C 102(b) was made in the previously mailed Office action, July 27, 2001. Only a Notification for a possible rejection under 35 U.S.C. 102(b) was set forth, page 12.

Applicant argues that to anticipate a claim then only one reference must be used in the rejection and not in combination. This argument is not persuasive because the rejection is based upon one printed publication, the published European application number 981669; see previously mailed Office action (Paper number 4, page 12). There is no combination of references.

Applicant argues that “By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it.”. This argument is not persuasive since the reference combined with the knowledge of one skilled in the art, puts the skilled artisan in possession of the claimed invention. “...The proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art

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and from this combination be put in possession of the invention on which a patent is sought.” *In re LeGrice*, 133 USPQ 365 (CCPA 1962).

Applicant then argues that the PBR certificate does not contain detailed information as would a plant patent and that the description in the certificate would not enable a skilled person in the art to asexually reproduce the plant. This argument is not persuasive because a more detailed description of the claimed cultivar would not confer novelty. See MPEP 2112.

Applicant argues that the plant in *In re LeGrice* was available only in a foreign country, and that the fact of the situation is the same in the instant application. This argument is not persuasive because in *LeGrice*, Applicant never admitted that the rose cultivar was on sale anywhere. Instead, Applicant stated that “Prior public use or sale are the avenues by which a plant enters the public domain” (*LeGrice*, pg. 372). The court then added “section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter” (*LeGrice*, pg. 372).

Applicant’s contention that the Court knew the claimed plant had been on sale and found that fact irrelevant is contrary to the written opinion cited above. The *LeGrice* decision repeatedly returns to the question of whether the invention was “in possession of the public”. Clearly, if an invention is on sale to the public, then the public must have possession of it. As stated by the Board of Appeals and Interferences in *Ex parte Thomson*, “the court’s holding was based on the specific “printed publication’s before it, and no indication was given that the “prior

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catalogue publication” before it evidenced commercial availability in a readily enabling form” (Pg. 1622).

Applicant argues that the Examiner should not rely on *Ex parte Thomson*, because that case involved an application for a utility patent. This argument is not persuasive because the question in *Thomson*, as in *LeGrice*, was, what is required to “enable” a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as the *Thomson* case. Moreover, Applicant has misconstrued the *Thomson* decision. The printed publications cited in *Thomson* were not enabled by Applicant’s deposit of seeds, but by commercial availability of the seeds *outside the U.S.* As stated in *Thomson*, “we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercial available Siokra seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokra plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market.”.

Applicant argues that the claimed plant was not available in the United States. This argument is not persuasive. Applicant is attempting to create a geographic component of enablement, which does not exist in statute or case law. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must

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be located in the United States. See, for example, *Ex parte Rinehart* (10 USPQ2d 1710), where a specification was found to be enabling even though the required biological material was only available in the ocean off the coast of Central and South America. Even if there were a requirement that the plant be available in the U.S., Applicant has not explained why the skilled rose grower could not have purchased the claimed plant and arranged for its importation into the U.S. through the usual channels (customs and USDA quarantine).

Applicant argues that one needs access to the claimed plant in order to reproduce it. This argument is not persuasive because the plant was made accessible by virtue of its sale to the public.

Applicant argues that testing of the claimed invention is required. Field trials or other testing of a plant variety are not a bar to patentability, so long as the plant is not placed in the public domain. In the instant application, however, Applicant has admitted that the claimed plant was placed in the public domain (through its sale) more than one year prior to the filing for a U.S. Plant Patent.

Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT L. BELL
PATENT EXAMINER**

Kent L. Bell